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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,627	06/28/2001	Bill Kitchen	23952-0037	5978
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SUTHERLAND II SUTHERLAND, ASBILL & BRENNAN, LLC 999 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER GRAHAM, CLEMENT B	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/892,627

Applicant(s)

KITCHEN ET AL.

Examiner

Clement B. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-65, 69, 71-81, 85 and 87-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-65, 69, 71-81, 85, 87-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-884)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 11/17/08.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/12/08 has been entered.
2. Claims 61-65, 69, 71-81, 85, 87-93 remained pending and claims 94-95 has been added.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 77 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 77 recite a process comprising receiving, calculating transmitting. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claims 1, 77 are directed towards a computer based system comprising modules or steps. Modules or steps can be interpreted as consisting of software per se, and software is not a patentable subject matter because it does not fall under a statutory class as being a process, machine, manufacture, or composition of matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 61-65, 69, 71-81, 85, 87-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson U.S. Patent 5, 978, 780 in view of Kolling et al (Hereinafter Kolling U.S. Patent 5, 963, 925).

As per claim 61, Watson discloses a method, comprising:
receiving billing information associated with a bill, calculating a payment date that pre-dates a due date in the received billing information based at least in part on a lead time associated with a remittance method for paying the bill on or before the due date (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4)

Watson fails to explicitly teach transmitting a presentation, wherein the presentation includes a payment indicator and a pre-populated payment request, wherein the pre-populated payment request includes the calculated payment date as a pre-populated payment date receiving a selection of the payment indicator and responsive to receiving the selection of the payment indicator, directing payment of the bill on behalf of a payor.

However Kolling discloses a coordinating entity 120 is responsible for providing the core systems, operating rules, standards and procedures to facilitate reliable service operation and participation by billers and consumer financial institutions 130. Entity 120 provides hardware, software, and network communication for implementing the ESP system, although portions of

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the ESP system may be distributed throughout environment 100. Coordinating entity 120 also maintains a universal biller file (UBF) (as in FIG. 4) and a statement template library (shown in FIG. 3). Once coordinating entity 120 receives statement information from a biller, it forwards this statement information to a consumer financial institution end point 130 for eventual delivery to a consumer 140. The function of coordinating entity 120 may be performed by a wide variety of businesses and organizations, by a government, and/or by a combination of organizations. In one specific embodiment of the present invention, the functions of coordinating entity 120 are performed by VISA of San Mateo, Calif., and communications are assisted by using its VisaNet network (see column 29 lines 62-67 and column 30 lines 1-18 and column 31 lines 57-67 and column 32 lines 1-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Watson to include transmitting a presentation, wherein the presentation includes a payment indicator and a pre-populated payment request, wherein the pre-populated payment request includes the calculated payment date as a pre-populated payment date receiving a selection of the payment indicator and responsive to receiving the selection of the payment indicator, directing payment of the bill on behalf of a payor taught by Kolling in order for a biller to direct a statement or invoice electronically to a consumer.

As per claim 62, Watson discloses further comprising: receiving an indication of a biller associated with the bill, and wherein transmitting a presentation is responsive to receiving the indication of the biller (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 63, Watson discloses wherein receiving an indication of the biller includes receiving a selection of the biller from a list of billers (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 64, Watson discloses wherein the list of billers is a list of names of electronic billers (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 65, Watson discloses wherein the pre-populated payment request is in a check format, wherein the check format includes at least one of the pre-populated payment date in a

check date location, the pre-populated identification of a biller in a check payee location, or the pre-populated payment amount is in a check amount location.

As per claim 69, Watson discloses wherein the presentation is a first presentation and the payment indicator is a first payment indicator, and further comprising: transmitting a second presentation, wherein the second presentation includes at least a portion of the billing information and an associated second payment indicator (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4) and receiving a selection of the second payment indicator, wherein the first presentation is transmitted responsive to receiving the selection of the second payment indicator (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 71, Watson discloses wherein the remittance method is one of a hardcopy check or an electronic funds transfer (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 72, Watson discloses wherein the pre-populated payment request includes at least one of (i) a pre-populated identification of a biller associated with the bill, or (ii) a pre-populated payment amount associated with the bill, wherein the pre-populated payment amount is the total bill amount (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 73, Watson discloses date, wherein receiving a selection of the payment indicator includes receiving a modified payment date with the selection of the payment indicator and wherein directing payment of the bill on behalf of a payor includes directing the payment of the bill in accordance with the modified payment date (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 74, Watson discloses wherein the pre-populated payment request includes a pre-populated payment amount (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4) wherein receiving a selection of the payment indicator includes receiving a modified payment amount with the selection of the payment indicator and wherein directing payment of the bill on behalf of a payor includes directing the payment of the bill in accordance with the modified payment amount (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-

67 and column 22 lines 1-4).

As per claim 75, Watson discloses wherein receiving a selection & the payment indicator includes receiving an indication that the payment should be paid more than once and receiving an indication of payment frequency (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

and wherein directing payment of the bill on behalf of a payor includes directing the payment of the bill in accordance with the indication that the payment should be paid more than once and the indication of payment frequency (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 76, Watson discloses wherein the payment frequency is one of weekly, biweekly, monthly, quarterly, triannually, semiannually, or yearly (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 77, Watson discloses a system, comprising:
a storage device, wherein the storage device includes software instructions;
a communications interface; and
a processor, in communication with the storage device and communication interface, wherein the processor is configured to execute the software instruction to:
receive billing information associated with a bill, calculate a payment date that pre-dates a due date in the received billing information based at least in part on a lead time associated with a remittance method for paying the bill on or before the due date (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

Watson fail to explicitly teach transmit the presentation, wherein the presentation includes a payment indicator and a pre-populated payment request, wherein the pre-populated payment request includes the calculated payment date as a pre-populated payment date receive via the communications interface, a selection of the payment indicator, and responsive to receiving the selection of the payment indicator, directing payment of the bill on behalf of a payor.

However Kolling discloses a coordinating entity 120 is responsible for providing the core systems, operating rules, standards and procedures to facilitate reliable service operation and participation by billers and consumer financial institutions 130. Entity 120 provides hardware, software, and network communication for implementing the ESP system, although portions of

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the ESP system may be distributed throughout environment 100. Coordinating entity 120 also maintains a universal biller file (UBF) (as in FIG. 4) and a statement template library (shown in FIG. 3). Once coordinating entity 120 receives statement information from a biller, it forwards this statement information to a consumer financial institution end point 130 for eventual delivery to a consumer 140. The function of coordinating entity 120 may be performed by a wide variety of businesses and organizations, by a government, and/or by a combination of organizations. In one specific embodiment of the present invention, the functions of coordinating entity 120 are performed by VISA of San Mateo, Calif., and communications are assisted by using its Visa Net network (see column 29 lines 62-67 and column 30 lines 1-18 and column 31 lines 57-67 and column 32 lines 1-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Watson to include transmit the presentation, wherein the presentation includes a payment indicator and a pre-populated payment request, wherein the pre-populated payment request includes the calculated payment date as a pre-populated payment date receive via the communications interface, a selection of the payment indicator, and responsive to receiving the selection of the payment indicator, directing payment of the bill on behalf of a payor taught by Kolling in order for a biller to direct a statement or invoice electronically to a consumer.

As per claim 78, Watson discloses wherein the processor is configured to execute additional software instructions to receive an indication of a biller (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 79, Watson discloses wherein the software instructions to receive an indication of the biller include receiving a selection of the billet from a list of billers (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 80, Watson discloses wherein the list of billers is a list of names of electronic billers (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 81, Watson discloses wherein the pre-populated payment request is in a check format, wherein the check format includes at least one of the pre-populated payment date in a check date location, a pre-populated identification of a biller in a check payee location, or a pre-

populated payment amount is in a check amount location (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 85, Watson discloses wherein the presentation is a first presentation and the payment indicator is a first payment indicator, and wherein the processor is configured to execute additional software instructions to transmit a second presentation(see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4) wherein the second presentation includes at least a portion of the billing information and an associated second payment indicator and

receive a selection of the second payment indicator, wherein the first presentation is transmitted responsive to receiving the selection of the second payment indicator (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 87, Watson discloses wherein the remittance method is one of a hardcopy check or an electronic funds transfer (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 88, Watson discloses wherein the pre-populated payment request includes at least one of (i) a pre-populated identification of a biller associated with the bill, or (ii) a pre-populated payment amount associated with the bill (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 89, Watson discloses wherein the software instructions receive a selection of the payment indicator include receiving a modified payment date with the selection the payment indicator; and wherein the software instructions to direct payment of the bill on behalf of a payor include directing the payment of the bill in accordance with the modified payment date (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 90, Watson discloses wherein the pre-populated payment request includes a pre-populated payment amount, wherein the software instructions of receiving receive a selection of the payment indicator include receiving a modified payment amount with the selection of the payment indicator(see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4)

and wherein the software instructions to direct payment of the bill on behalf of a payor include

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directing the payment of the bill in accordance with the modified payment amount (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 91, Watson discloses wherein the software instructions to receive a selection of the payment indicator include receiving an indication that the payment should be paid more than once and receiving an indication of payment frequency (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4) and wherein the software instructions for to direct payment of the bill on behalf of a payor include directing the payment of the bill in accordance with the indication that the payment should be paid more than once and the indication of payment frequency (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 92, Watson discloses wherein the payment frequency is one of weekly, biweekly, monthly, quarterly, triannually, semiannually, or yearly (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 93, Watson discloses a system, comprising:
means for receiving billing information associated with a bill;
means for calculating a payment date that pre-dates a due date in the received billing information based at least in part on a lead time associated with a remittance method for paying the bill on or before the due date(see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

Watson fail to explicitly teach means for transmitting a presentation, wherein the presentation includes a payment indicator and a pre-populated payment request, wherein the pre-populated payment request includes the calculated payment date as a pre-populated payment date at least one of a pre populated payment date derived from a due date of the bill, a pre populated identification of a means for receiving a selection of the payment indicator and responsive to receiving the selection of the payment indicator, means for directing payment of the bill on behalf of a payor.

However Kolling discloses a coordinating entity is responsible for providing the core systems, operating rules, standards and procedures to facilitate reliable service operation and participation by billers and consumer financial institutions. Entity provides hardware, software, and network communication for implementing the ESP system, although portions of the ESP

system may be distributed throughout environment. Coordinating entity also maintains a universal biller file (UBF) (as in FIG. 4) and a statement template library (shown in FIG. 3). Once coordinating entity receives statement information from a biller, it forwards this statement information to a consumer financial institution end point 130 for eventual delivery to a consumer. The function of coordinating entity may be performed by a wide variety of businesses and organizations, by a government, and/or by a combination of organizations. In one specific embodiment of the present invention, the functions of coordinating entity are performed by VISA of San Mateo, Calif., and communications are assisted by using its VisaNet network (see column 29 lines 62-67 and column 30 lines 1-18 and column 31 lines 57-67 and column 32 lines 1-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Watson to include means for transmitting a presentation, wherein the presentation includes a payment indicator and a pre-populated payment request, wherein the pre-populated payment request includes the calculated payment date as a pre-populated payment date at least one of a pre populated payment date derived from a due date of the bill, a pre populated identification of a means for receiving a selection of the payment indicator and responsive to receiving the selection of the payment indicator, means for directing payment of the bill on behalf of a payor taught by Watson in order for a biller to direct a statement or invoice electronically to a consumer.

As per claim 94, Watson discloses wherein the lead time varies depending on the remittance method used for payment (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

As per claim 95, Watson discloses wherein the lead time varies depending on the remittance method used for payment (see column 2 lines 11-15 and column 13 lines 10-25 and column 21 lines 36-67 and column 22 lines 1-4).

CONCLUSION

RESPONSE TO ARGUMENTS

7. Applicant's arguments filed 11/12/08 has been fully considered but they are moot in view of new grounds of rejections.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frantzy Poinvil/
Primary Examiner, Art Unit 3696

CG

Dec 19, 2008